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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <u>8932-890-999</u>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number <u>10/823,215</u>		Filed <u>April 12, 2004</u>
	First Named Inventor <u>Rathbun et al.</u>		
	Art Unit <u>3731</u>	Examiner <u>David A. Bonderer</u>	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 54,390
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature
Brent P. Ray

Typed or printed name
212-326-8358

Telephone number
December 20, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 8932-890-999

Group Art Unit: 3731)
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Examiner: David A. Bonderer)
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Inventor: Rathbun et al.)
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Serial No.: 10/823,215)
)
Filed: April 12, 2004)
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For: Free Hand Drill Guide)
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**PRE-APPEAL BRIEF
CONFERENCE REQUEST**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Final Rejection mailed September 22, 2005 ("Final Rejection") of the above-captioned application prior to filing an appeal brief for the reasons set forth below. Applicants submit that the Final Rejection fails to establish a *prima facie* rejection.

I. PROSECUTION SUMMARY

Independent claims 1, 19, 37, and 46 were rejected in a Non-Final Office Action mailed December 9, 2004 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,669,915 to Caspar et al. (“Caspar”). In response, Applicants:

- amended claim 1 to recite that “the guide barrel is not pivotable relative to the alignment assembly;”
- amended claim 19 to recite that “the guide barrel has a substantially different length than the alignment assembly;” and
- amended claims 37 and 46 to recite that “the housing is integral with the guide barrel.”

In response, the Examiner finally rejected Claims 1, 19, 37, and 46 in the Final Rejection¹ — rejecting claim 1 under 35 U.S.C. § 102(b) as being anticipated by Caspar, and rejecting claims 19, 37, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Caspar. In regards to claim 1, the Examiner stated of Caspar that “[t]he location post is pivotable while in the recess of the bone plate, but is also capable of being retained so as not to pivot.” (Final Rejection at 2). Moreover, in regards to claim 19, the Examiner asserted that despite the identical sleeves described in Caspar, it would have been obvious to “form the guide barrel to have a substantially different length than the alignment assembly,” citing *In re Aller*, 105 U.S.P.Q. 233 (C.C.P.A. 1955). (Final Rejection at 3). Finally, in regards to claims 37 and 46, the Examiner stated that despite the pivotably-related sleeves of Caspar, it would have been obvious to make the two sleeves integral, citing *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). (Final Rejection at 4).

II. FAILURE TO ESTABLISH A *PRIMA FACIE* CASE OF ANTICIPATION AND OBVIOUSNESS

A *prima facie* case of anticipation or obviousness has not been made with regard to independent claims 1, 19, 37, and 46 because the cited art fails to describe each and every

¹ For completeness, claims 45 and 49-55 were cancelled without prejudice, and claims 56-63 were allowed.

claim element of claim 1, and fails to disclose, teach, or suggest each and every element of claims 19, 37, and 46.

A. Independent Claim 1

As stated above, independent claim 1 recites a drill guide having a guide barrel and alignment assembly, “wherein the guide barrel is not pivotable relative to the alignment assembly.” Caspar, in contrast, describes a drilling jig 1 having two sleeves 2 associated with a holder 4 via arms 3, such that sleeves 2 are pivotably related to each other (*see* Caspar at 3:29-31, Fig. 1), which in turn:

[M]akes it possible for a larger number of drilling positions which are, for example, necessary for fixing a bone plate on a bone to be defined by different sleeves, but with only a single instrument being necessary *and having to be placed in position once*....Herein it is expedient for the sleeves to be mounted on the holder so as to be *pivotable in relation to each other* about an axis of rotation extending perpendicular to their longitudinal axis. This makes it possible for the sleeves to also be placed at drilling points whose spacing differs slightly from the mutual spacing of the drill sleeves.

(Caspar at 2:50-65) (emphasis added). Thus, Caspar describes sleeves 2 pivotably attached to each other to achieve the advantages of multiple drilling positions while requiring the single placement of the instrument.

Despite clear language to the contrary, the Examiner stated in the Final Rejection that the Caspar device “can be retained in place, for example, held by a user, so as to not be pivotable.” (Final Rejection at 5). This assertion runs afoul of the express description of Caspar, which discloses that sleeves 2 are pivotable with respect to one another to provide multiple drilling locations without having to reposition the instrument. The act of holding the sleeves “in place...by a user” does not change the fact that the sleeves would still be, in fact, pivotable. Components may be pivotably related without actually pivoting at a specific moment in time.²

² Caspar’s disclosure of sleeves not pivoting when completely parallel is equally unavailing. (*See* Caspar at 2:66-3:3). That the joint is such that the arms are not pivoted when the sleeves are parallel does not alter the underlying pivotable nature of the joint connecting the sleeves themselves.

Applicants accordingly submit that Examiner has not made out a *prima facie* case of anticipation of independent claim 1. Applicants therefore submit that independent claim 1, in addition to dependent claims 2-18, are allowable.

B. Independent Claim 19

Independent claim 19 recites a surgical drill guide having a guide barrel and an alignment assembly, “wherein the guide barrel has a substantially different length than the alignment assembly.” In contrast, Caspar describes sleeves 2 of equal length, and completely identical design. (See Caspar at 2:49, 3:25-26, 3:38-40, 4:62-63 (claim 1), Fig. 1). In fact, because the described sleeves 2 are identical, the Caspar patentee proclaimed that “only one of these sleeves will be explained in greater detail.” (*Id.* at 3:38-40). That both Caspar sleeves 2 are identical is consistent with their common purpose — to receive drilling tool 12 through bore 28. This fact stands in contrast to claim 19, wherein the guide barrel has a bore “configured to receive a bone cavity forming tool,” and also has an alignment assembly “for aligning the bone tool with a selected...fastener hole.” (See claim 19). Thus, Applicants submit that *In re Aller* is inapplicable, because modifying Caspar to provide a guide barrel and an alignment assembly of “substantially different length” does not represent an “optimum or workable range,” for the Caspar device. There is no suggestion or motivation to modify Caspar to arrive at the device of claim 19. See *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”).

Applicants accordingly submit that because “completely identical” sleeves cannot have “substantially different length[s],” the Examiner has not made out a *prima facie* case of obviousness of independent claim 19. Applicants therefore submit that independent claim 19, in addition to dependent claims 20-36, are allowable.

C. Independent Claims 37 and 46

Independent claims 37 and 46 each recite a drill guide assembly having a guide barrel and alignment assembly having a housing, "wherein the housing is integral with the guide barrel." Caspar states that "the other arm 3 is pivotable about an axis of rotation in relation to the first arm 3....This axis of rotation is formed by a screw which passes through both arms." (Caspar at 3:30-34). The sleeves are pivotable about a joint formed by a screw, and therefore are not "integral." Moreover, it is clear from Caspar that sleeves 2 are pivotably related to allow the device to achieve its stated advantage of enabling "a larger number of drilling positions...with only a single instrument being necessary and having to be placed in position once." (*Id.* at 2:50-55). Caspar therefore actually teaches against making sleeve 2 integral.

The Examiner cites *Howard v. Detroit Stove Works* as support for the assertion that it would be obvious to make integral the pivotably connected sleeves 2 of Caspar. However, as a "general rule," a reference that teaches away cannot serve to create a *prima facie* case of obviousness. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

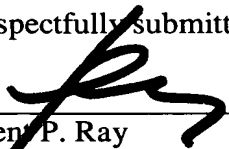
Applicants accordingly submit that Examiner has not made out a *prima facie* case of obviousness of independent claims 37 and 46. Applicants therefore submit that independent claims 37 and 46, in addition to dependent claims 38-44 and 47-48, are allowable.

III. CONCLUSION

For at least the above reasons, Applicants submit that claims 1-44, 46-48, and 56-63 are in condition for allowance.

Respectfully submitted,

Date: December 20, 2005


Brent P. Ray
For: Brian M. Rothery
(Reg. No. 35,340)

54,390
(Reg. No.)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939